

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: § Confirmation No.: 2662
Donald W. Verser et al. §
Serial No.: 10/699,095 § Group Art Unit: 1796
Filed: October 31, 2003 § Examiner: Lu, C. Caixia
For: Separation of Polymer Particles and § Atty. Docket: CPCM:0016
Vaporized Diluent in a Cyclone § 210441US00

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37 C.F.R. 1.8

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May 26, 2009	/W. Allen Powell/
Date	W. Allen Powell

REQUEST FOR RECONSIDERATION PURSUANT TO 37 C.F.R. § 41.52
IN RESPONSE TO THE DECISION ON APPEAL MAILED MARCH 24, 2009

This Request for Rehearing is being filed pursuant to 37 C.F.R. § 41.52 in response to the Board of Patent Appeals and Interferences's Decision on Appeal mailed on March 24, 2009. Specifically, this Request for Rehearing states with particularity multiple points believed to have been misapprehended or overlooked by the Board. However, in the interest of brevity, Appellants address below only those points from the Decision on Appeal that are particularly noteworthy. Accordingly, Appellants reserve the right to address additional points from either the Decision on Appeal or the previously filed Appeal Brief in a subsequent appeal of the Board's decision. To the extent that any of the arguments set forth herein are considered new arguments, Appellants assert that they are presented for good cause in accordance with 37 C.F.R. § 41.52.

The Board Misapprehended the Specification and the Appellants Arguments

In the Decision on Appeal, the Board found that the Examiner erred in rejecting claims 37-40, and 42 under 35 U.S.C. § 103 as being obvious over Kendrick in view of Hanson '892 because Kendrick is not prior art with respect to these claims. Decision on Appeal, page 14. However, the Board sustained the Examiner's rejection of claims 37-40 and 42 under 35 U.S.C. § 103 as being obvious over Tormaschy in view of Hanson '892 and Hanson '341. The Board affirmed all of the Examiner's other rejections of the pending claims. While Appellants do not agree with the Boards decision regarding all of the pending claims, the present Request is directed to claims 37-40 and 42. Indeed, Appellants believe the Board has clearly misapprehended and overlooked certain facts and arguments in sustaining the Examiner's rejection based on Tormaschy, Hanson '892, and Hanson '341.

First, Appellants assert that the Board has overlooked certain portions of the disclosure which relate to "withdrawing substantially continuously" a discharge slurry from a reactor. In the Decision on Appeal, the Board interpreted "withdrawing substantially continuously" as encompassing at least some batch removal along with continuous removal. Decision on Appeal, page 21. The Board appeared to base this decision on the fact that the specification includes some discussion of batch procedures. *See* Decision on Appeal, page 17. However, Appellants believe the Board overlooked portions of the specification that clarify the meaning of "withdrawing substantially continuously." For example, in paragraph [0063], the specification sets forth the following:

The particles of polymer solids may substantially close off the majority of flow path (cross sectional area) available to the diluent. Nonetheless, it is contemplated that a small amount of flow path may be available through the small gaps between adjacent particles. This small continuous flow may reduce the ultimate recovery efficiency of diluent in the intermediate pressure zone.

Application, page 19, paragraph [0063]. In view of this disclosure, Appellants assert that one of ordinary skill in the art would not interpret “withdrawing substantially continuously” as including any batch operations. Rather, Appellants believe it is clear that the term indicates a consistently continuous withdrawal that varies occasionally in flow rate due to partial closing off of the flow path.

Second, regardless of whether “withdrawing substantially continuously” is interpreted as encompassing both batch and continuous removal or just varying flow rates of continuous removal, Appellants maintain that Tormaschy fails to sufficiently disclose a *continuous* withdrawal of slurry *from the reactor*. Indeed, Tormaschy certainly fails to disclose “withdrawing substantially continuously via a valve a discharge slurry from the reactor,” as recited in claim 37. For example, with regard to the assertion that Tormaschy discloses continuous withdrawal because it discloses removal of slurry in pounds per hour, Appellants stress that even a batch process will have a flow rate when material is removed. In other words, the results of a batch process are not simply ejected in whole but are allowed to flow out. Accordingly, Appellants stress that merely disclosing a flow rate of removal from a batch process is not the same as “withdrawing substantially *continuously*” from the reactor.

Additionally, in what is essentially a new argument, the Board asserted that Miller (which is incorporated by reference in Tormaschy) discloses “withdrawal of slurry from the reactor and, in so doing, discloses that the withdrawal can be continuous or intermittent.” Decision on Appeal, page 21. However, Appellants stress that Tormaschy (including Miller) merely appears to disclose a typical settling leg configuration, and *not* a continuous withdrawal from the reactor as would be understood based on the present disclosure. Indeed, while the term “continuous” is apparently utilized in Miller, it appears to be directed to some manner of maintained flow through a typical settling leg configuration. Indeed, as noted by the Board, the specification states that “[t]he effluent from the reactor 11 is withdrawn through *a product conduit 19*, which can be a drain or vertical leg.” Miller et al., col. 2, lines 52-54. Thus, whether characterized as a drain or a

vertical leg, the effluent is withdrawn through a *conduit*, which is clearly illustrated as a typical settling leg configuration in FIG. 1 of Miller. Furthermore, Tormaschy itself certainly does not disclose continuous withdrawal of slurry from the loop reactor. Indeed, as previously asserted, based on the date of the reference and on Appellants' understanding of the Tormaschy patent, Appellants strongly believe that the Tormaschy systems incorporate the typical settling leg configuration, and *not* a continuous withdrawal from the reactor. Further, the Declaration of John D. Hottovy under 37 C.F.R. § 1.132 (previously-submitted with the Appeal Brief) further clarifies that Tormaschy does not disclose or even contemplate a continuous withdrawal.

It should also be noted that claim 37 recites that the continuous withdrawal is “*via a valve*” and “*from the reactor*.” (Emphasis added). It appears that the Board overlooked this particular aspect of the claim language and the Appellants’ related arguments. *See* Appeal Brief, page 18. In contrast to the claim recitations set forth above, Miller discloses a flow rate valve 21 that regulates the withdrawal of effluent *from a product conduit 19*, not from the reactor 111. Miller et al., col. 2, lines 52-58; FIG. 1. Further, claim 37 also recites that “the discharge slurry has a solids concentration greater than the solids concentration of the slurry in the reactor,” and the Board essentially asserted that a higher concentration of solids would accumulate in the conduit 19 of Miller due to gravity. Decision on Appeal, page 23. However, this interpretation fails to give weight to the claim language indicating that the continuous withdrawal is “*via a valve*” and “*from the reactor*,” as recited in claim 37. In stark contrast, the allegedly higher concentration solids of Miller are being withdrawn from the product conduit 19, not the reactor.

Specifically with regard to the recitation that “the discharge slurry has a solids concentration greater than the solids concentration of the slurry in the reactor,” the Board found that the Examiner’s assertion of inherency based on gravity was reasonable and shifted the burden to the Appellants to show that the prior art apparatus would not, in fact, result in the claimed higher solids content. Decision on Appeal, page 23. In coming

to this conclusion, the Board discussed both the actual disclosure of Tormaschy and the incorporated disclosure of Miller. *Id.* As set forth above, the Board's assertions with regard to Miller relate to obtaining effluent from a product conduit, not from a reactor. Indeed, it appears that the Board overlooked this subtlety. Accordingly, to the extent that the Board relies on Miller for disclosing withdrawal of a discharge slurry from a reactor via a valve, wherein the discharge slurry has a solids concentration greater than the slurry in the reactor, Appellants assert that the argument is moot. Further, the Examiner's apparent initial assertion that the reactor in Tormaschy discloses this recited feature is believed to be clearly incorrect. Indeed, the reactor disclosed by Tormaschy is "manipulated so as to prevent the polymer solids from settling out of the circulating reaction slurry and plugging the reactor 11." Tormaschy, Abstract. Accordingly, the Examiner's speculation about settling of solids due to gravity at an outlet toward the bottom of the reactor in Tormaschy is essentially contradicted by the disclosure of Tormaschy itself. This fact is believed to be sufficient to overcome the Appellants burden to show that the prior art apparatus would, in fact, not result in the claimed higher solids content.

Further, in view of what is essentially a new position asserted by the Board based on Miller, Appellants stress that, much like a patent application, prior art must also be enabled. *See Rasmussen v. SmithKline Beecham Corp.*, 75 U.S.P.Q.2d 1297 (Fed. Cir. 2005) (acknowledging a difference in standards but maintaining that a reference must be enabling to be anticipatory). Indeed, in determining that quantum of prior art disclosure which is necessary to declare an applicant's invention "not novel" or "anticipated" within section 102, the stated test is whether a reference contains an "enabling disclosure." *In re Hoeksema*, 399 F.2d 269, 158 U.S.P.Q. 506 (C.C.P.A.1968) (emphasis added). The disclosure in an assertedly anticipating reference must provide an *enabling* disclosure of the desired subject matter; *mere naming* or description of the subject matter is *insufficient*, if it cannot be produced without undue experimentation. *Elan Pharm., Inc. v. Mayo Foundation for Medical and Education Research*, 346 F.3d 1051, 1054, 68 U.S.P.Q.2d 1373, 1376 (Fed. Cir. 2003) (emphasis added). Moreover, an unwitting

disclosure which is accidental and unappreciated does not anticipate the present claims.

See Schering Corp. v. Geneva Pharm., Inc., 339 F.3d 1373 (Fed. Cir. 2003); *Eibel Process Co. v. Minnesota & Ont. Paper Co.*, 261 U.S. 45 (1923); *Tilghman v. Proctor*, 102 U.S. 707, 26 L.Ed. 279 (1880). While the present rejection is based on obviousness and not anticipation, Appellants assert that Tomraschy is not enabled with regard to “withdrawing substantially continuously via a valve a discharge slurry from the reactor, the discharge slurry comprising withdrawn solid polymer particles and withdrawn liquid, wherein the discharge slurry has a solids concentration greater than the solids concentration of the slurry in the reactor,” as recited in 37. Indeed, at best, Tomraschy (which incorporates Miller) merely discloses continuous or intermittent withdrawal through a product conduit, which appears to be a component of a traditional settling leg configuration.

Conclusion

Appellants respectfully submit that all pending claims are in condition for allowance. However, if any member of the Board wishes to resolve any other issues by way of a telephone conference, the member of the Board is kindly invited to contact the undersigned attorney at the telephone number indicated below.

Respectfully submitted,

Date: May 26, 2009

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